

REMARKS

This Application has been carefully reviewed in light of the Office Action transmitted September 12, 2007 (the "Office Action"). The Office Action rejects Claims 1-5, 7-13 and 15-19. Applicant respectfully requests reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-5, 7, 9-13, 15, and 17-19 under 35 U.S.C. 103(a) as being unpatentable over European Patent Office Publication No. 1096713 to Yoshizawa et al. ("*Yoshizawa*") in view of U.S. Patent Publication No. 2003/0223682 to Kinoshita et al. ("*Kinoshita*"). The Examiner rejects Claims 8 and 16 under 35 U.S.C. 103(a) as being unpatentable over *Yoshizawa* in view of *Kinoshita*, as applied to Claims 1-5, 7, 9-13, 15 and 17-19 above, and further in view of U.S. Patent Publication No. 2002/0048066 to Antoniadou et al. ("*Antoniades*"). Applicant respectfully traverses these rejections.

Applicant previously submitted a Declaration Pursuant to 37 C.F.R. § 1.131 (the "Declaration") swearing behind *Kinoshita* such that *Kinoshita* only qualifies as a Section 103 prior art reference under Section 102(e). Applicant indicated that Section 103(c) prevents *Kinoshita* from being available as a prior art reference for use in Section 103 rejections.

In response, the Office Action states that:

[T]he declaration is not effective for at least two reasons. First, it states that prior to 4 December 2003 the applicant "was working to reduce the subject matter to practice through a patent application". This statement does not establish reduction to practice prior to 4 December 2003, only that the applicant was "working to reduce...". It appears that reduction to practice occurred after 4 December 2003, by way of the filing of the application.

Office Action, page 2. The Office Action also states that:

The Declaration does not establish reduction to practice prior to the publication date of *Kinoshita*, nor does it establish that there was conception prior to the publication date of *Kinoshita* coupled with due diligence. Diligence is described in MPEP § 2138.06. The Declaration does not account for by either affirmative acts or acceptable excuses *the entire period* during which diligence is required.

Office Action, pages 2-3.

In order to swear behind a reference, Applicant must show facts "as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." 37 C.F.R. § 1.131. *Kinoshita's* publication date is December 4, 2003. *See Kinoshita*. The Declaration states that prior to December 4, 2003, the inventor developed an understanding and appreciation of the subject matter of at least the rejected claims and was working to reduce the subject matter to practice through a patent application. *See Declaration*, ¶ 4. For example, the inventor met with a patent attorney to discuss the subject matter on October 29, 2003. *See id.* The Declaration also states that the attorney forwarded a draft of the patent application to the inventor on December 5, 2003; that the inventor reviewed the draft between December 5, 2003 and December 12, 2003; that the inventor provided comments on the draft on or about December 12, 2003; that on or about December 12, 2003 the attorney forwarded the application with a Declaration and Power of Attorney and an Assignment for execution by the inventor; and that the inventor executed these papers and the application was filed on December 12, 2003. *See id.* Given the *Kinoshita* publication date of December 4 and the filing of the present application on December 12, the entire period for which diligence must be shown is eight days. With respect to diligence required in preparing and filing a patent application, the M.P.E.P. states that "[s]ix days to execute and file application is acceptable." M.P.E.P. § 2138.06 (citing *Haskell v. Coleburne*, 671 F.2d 1362 (CCPA 1982)). Applicant has demonstrated that between December 4 and December 12, 2003, the inventor received the application, reviewed the application, provided comments on the application, and executed the application for filing. Thus, given the M.P.E.P. and relevant caselaw, Applicant has effectively sworn behind *Kinoshita* as a 102(a) reference.

The Office Action additionally indicates that the Declaration is insufficient because it "does not establish that the subject matter of *Kinoshita* and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Office Action, page 3. However, this information does not have to be provided in such a declaration. The M.P.E.P. states that a statement alone by an applicant or representative that the application and the reference, were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person is sufficient

evidence. *See* M.P.E.P. § 706.02(1)(2)II. Applicant provided such a statement on page 7 of its Response to Office Action Pursuant to 37 C.F.R. § 1.111 filed January 3, 2007.

Therefore, given the submitted Declaration swearing behind *Kinoshita* such that *Kinoshita* only qualifies as a Section 103 prior art reference under Section 102(e) and given that Section 103(c) prevents *Kinoshita* from being available as a prior art reference for use in Section 103 rejections, Applicant respectfully requests allowance of Claims 1, 9 and 17 and all claims depending therefrom.

ATTORNEY DOCKET NUMBER
064731.0394

PATENT
10/734,629

- 10 -

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicant, at the Examiner's convenience at (214) 953-6511.

The Commissioner is hereby authorized to charge the amount of \$790.00 in payment of the required fee to file a Request for Continued Examination, any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Chad C. Walters
Reg. No. 48,022
(214) 953-6511

Date: December 12, 2007

CORRESPONDENCE ADDRESS:

Customer Number: **05073**